

**REMARKS**

Prior to this paper, claims 1-19 were pending in the application. By this paper, claims 1, 2, 3, 5, 6, 7 and 8 are amended. Claims 20 and 21 are added, and no claims are cancelled. Therefore, claims 1-21 are now pending in the present application.

**Allowable Subject Matter**

Applicants thank Examiner Shewareged for indicating that claims 3-8, 11-16 and 19 are allowable in view of the prior art.

**Interview of August 26, 2003**

Examiner Shewareged and Supervisor Kelly are thanked for extending to Applicants' representatives an in-person interview on August 26, 2003, where Applicants' representative presented proposed amendments to the claims to utilize "adapted" language and presented excerpts from the MPEP (reiterated in greater detail below) that support Applicants' position that the language following "adapted" should be given patentable weight. Examiner Shewareged and Supervisor Kelly agreed too consider giving the term patentable weight.

During the interview, Applicants' representative further presented amendments to the claims removing the "characterized in that" language from the claims and replacing it with the language "a cellulose ether that." Examiner Shewareged and Supervisor Kelly agreed that these amendments would be entered and that the amendments did not alter the scope of the claims.

**Rejections Under 35 U.S.C. § 102**

Claims 1, 2, 9, 10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Breckwoldt (USP 5,166,333), Koch I (USP 3,840,395), Koch II (USP 3,899,452), while claims 17 and 18 stand rejected under the same statute section as being anticipated by Breckwoldt.

In response, Applicants have made the above clarifying amendments to claims 1 and 2 to clearly specify that the language following the term “adapted” is a structural feature of the present invention and that this language should be given patentable weight. Thus, Applicants respectfully submit that the above claims are allowable for the reason that none of the cited references teach each and every element of claims 1 and 17, the independent claims of the present invention, and that the claims that depend from the independent claims are likewise allowable.

The three cited references each fail to teach the element of a “film sheet *adapted for use with overhead projectors* comprising a cellulose either *without intervention of a layer adapted to be receptive to a jet printing ink*,” and the element of a film sheet “*adapted to receive ink directly from an ink-jet printer*,” in combination with the other recitations of the claims.

In the office action, these absent elements were not given patentable weight as structural limitations, and they were not identified in any of the three references (they could not have been identified in the references, as the reference do not teach these elements). Applicants respectfully assert that the feature following the term “adapted” should be given patentable weight as a structural element because the claims presents structural attributes of the present invention. In support of this assertion, Applicants rely on the last paragraph of MPEP § 2173.05(g), which states that “the Court held that limitations such as ‘members *adapted to be positioned*’ and ‘portions . . . being resiliently dilatable whereby said housing may be slidably positioned’ serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).” (Emphasis added.) *In re Venezia* has not been overruled, and it is cited for various purposes in about 5 other cases. Still further, over 400,000 Patents have issued since the ruling that contain term “adapted” in the claims.

Applicants recognize that *In re Hutchinson* is sometimes referenced as holding that the term “adapted” does not connote a structural limitation. *Hutchinson* does indeed state that the term “adapted” does not constitute a limitation, but this ruling was based on the fact that the term was located in the introductory (preamble) clause of the claim: “the first phraseology italicized by appellant *is the introductory clause* to the effect that the laminated article is

‘adapted’ for use in making a template or the like.” *In re Hutchinson*, 154 F.2d 135, 141 (CCPA 1970). (Emphasis added.) It is well settled that preambles are not given patentable weight unless the preamble language breathes life into the claim. Thus, in *Hutchinson*, the term was ignored as a limitation. In contrast to *Hutchinson*, the term “adapted” is used in the body of the claim. Therefore, in view of *Venezia*, it does define a structural attribute of the present invention. Furthermore, even if *Hutchinson* was on point, it has been overruled by *Venezia*, as *Venezia* was decided in 1976. (It is further noted that the MPEP does not cite *Hutchinson*.)

Applicants submit that the term “adapted” invokes a functional limitation per MPEP § 2173.05(g). MPEP § 2173.05(g) states that a “functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context of which it is used.” Applicants further submit that one of ordinary skill in the art would indeed recognize what the language following the term “adapted” conveys, and would recognize what is included and excluded from the scope of coverage of claims 1 and 17.

Thus, Applicants respectfully submit that claims 1 and 17 are allowable for at least the reason that the recitations following the term “adapted” must be given patentable weight and none of the references disclose these recitations. Reconsideration is respectfully requested.

#### Other Claim Amendments

As was presented in the August 26<sup>th</sup>, 2003 interview, claims 3 and 5-8, are amended by this response to place them in better compliance with U.S. format. These amendments do not narrow the scope of any feature recited therein. Applicants respectfully submit that these claims continue to remain in condition for allowance.

#### New Claims

Claims 20 and 21 are added to further distinguish the present invention from the cited references. Applicants submit that these claims are allowable for at least the reason that they depend from claims 1 and 17, respectively, and for the reason that none of the cited references

teach a transparency medium having either characters or pictures comprising dried or cured ink-jet ink thereon. Allowance is respectfully requested.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Shewareged and Supervisor Kelly are invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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